

In re MICHAELI ET AL., Application No. 09/845,606
Amendment F

REMARKS

The Office action dated November 29, 2006, and the references cited have been fully considered. In response, please enter the amendment to correct a typographical error in claim 51 and consider the following remarks presented herein. Reconsideration and/or further prosecution of the application is respectfully requested.

Applicants appreciate the thoughtful examination of the application, but respectfully submit that the case is in condition for allowance, and respectfully request that all rejections be withdrawn, all claims be allowed, and the case be passed to issuance. Especially *if the Office performed its duty as required by MPEP § 706 and 37 CFR 1.104(c)(2) and cited the best art available*, then as all claims are allowable over the prior art of record for at least the reasons presented herein, *then all claims are allowable over the best prior art available*. This case has been pending for an exceeding long duration, and it is time to issue the case.

First, Applicants respectfully traverse the § 101 rejections as the claim language of "configured to" in an apparatus claims does not render a claim unpatentable subject matter. The Office relies upon *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998) ("*State Street Bank*") for its authority for its § 101 rejections of independent claims 1, 13 and 33. *Au contraire*, *State Street Bank* teaches that such language does in fact comply with § 101. The Office seemingly is applying a statement of a holding of *State Street Bank* in the abstract, which is inconsistent with our system of laws and can lead to improper results - such is the case here. In fact, not much analysis of *State Street Bank* (nor other § 101 cases) is required to successfully traverse the § 101 issue at hand. The Federal Circuit in properly construing the recited first-fifth means limitations of claim 1 at issue in *State Street Bank*, construe them to be "an arithmetic logic circuit *configured to*" *Id.* at 1599 (*emphasis added*). Applicants respectfully submit that if the Federal Circuit believes that limitations of apparatus claims corresponding to "configured to" limitations comply with § 101, then Applicants' claims comply with § 101. For at least these reasons, Applicants respectfully request that the § 101 rejections be withdrawn.

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In terms of the rejections based on prior art, all claims stand rejected as being anticipated by Gutierrez et al., US Patent 6,570,850 or being unpatentable over Gutierrez et al. in light of Parruck et al., US 7,002,916. The Office repeats much of the same analysis throughout the Office, so Applicants will first address this analysis in general in regards to claim 1, and then discuss the other independent claims.

Similar to its § 101 analysis in which it literally misapplied a hold without regards to its meaning, the Office is apparently making the same type of mistake in the prior art analysis in that it apparently is looking for similar words without regards to their semantics and overall teachings of a coherent system. Turning to claim 1, the Office action equates

- the recited "distributor" with Gutierrez et al.'s receive scheduler 43;
- the recited "storage elements" with Gutierrez et al.'s buffer store 63; and
- the recited "receiver" with Gutierrez et al.'s transmit scheduler 53.

First, Applicants note that these elements are not in different devices and do not interact as recited in the claims as Gutierrez et al. teaches that its buffer store 63 is in a switching node while Gutierrez et al.'s receive scheduler 43 and transmit scheduler 53 are in a computer system. Gutierrez et al., col. 3, lines 43-46. Gutierrez et al. is directed to communicating information between different computer systems using virtual circuits through switching nodes, and neither teaches nor suggests that its receive scheduler 43 distributes packets to its buffer store with its transmit scheduler receiving these same packets (per basic antecedent basis requirements).

For at least these reasons, the Office action fails to present a *prima facie* proper rejection of claim 1 and its dependent claims. Moreover and for at least these same reasons, Applicants submit that Gutierrez et al. neither teaches nor suggests the recited limitations of independent claim 1 and its dependent claims 2, 3, 29, 30, 35, and 36.

The Office relies on this same rational in rejecting independent claim 13. Therefore, for at least these reasons, the Office action fails to present a *prima facie* proper rejection of claim 13 and its dependent claims. Moreover and for at least these same reasons, Applicants submit that

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Gutierrez et al. neither teaches nor suggests the recited limitations of independent claim 13 and its dependent claims 14, 15, 31, 32, 37 and 38.

The Office relies on this same rational in its § 103 rejections of independent claims 23, 33, 44, and 48. Therefore, for at least these reasons, the Office action fails to present a *prima facie* proper rejection of claims 23, 33, 44, and 48 and their dependent claims. Additionally, the Office relies on Parruck et al. for teaching additional limitations, with the motivation for the combination of these references for better traffic shaping. Applicants respectfully further suggest that such combination is improper and teaches away from the recited limitations in each pending claim. Shaping is concerned with changing the order of packets being output from a device, such as based on the different classifications of the packets. Therefore, Parruck et al. neither teaches nor suggests placing the information in storage and removing from storage in the same order; and in fact, teaches away from such (i.e., it is directed to shaping traffic). Additionally, requiring that the packets be removed from storage in the same order that they were placed in storage defeats the entire purpose of packet shaping and would render Parruck et al. unsatisfactory for its intended purpose of packet shaping and is therefore not a proper combination per MPEP § 2143.01(V). Moreover and for at least these same reasons, Applicants submit that Gutierrez et al. neither teaches nor suggests the recited limitations of independent claims 23, 33, 44, and 48, and their dependent claims 34, 41-43, 45-47, and 49-51.

Finally, it is well-established law that the burden is on the Office to initially present a *prima facie* unpatentability (e.g., anticipation, obvious) rejection, before Applicant has any burden of proof of disproving any application of a cited reference against a claim. *In re Warner*, 379 F2d. 1011, 1016, 154 USPA 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 USPQ2d 1788, 1788-89 (B.P.A.I. 1986). Therefore, for at least the reasons presented herein, the Office action fails to include a *prima facie* unpatentability rejection of any claim, and Applicants have no further duty to discuss any other issues or application of a cited reference against a claim.

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Again, Applicants appreciate the thoughtful examination of the application, but respectfully submit that the case is in condition for allowance, and respectfully request that all rejections be withdrawn, all claims be allowed, and the case be passed to issuance. Especially if the Office performed its duty as required by MPEP § 706 and 37 CFR 1.104(c)(2) and cited the best art available, then as all claims are allowable over the prior art of record for at least the reasons presented herein, then all claims are allowable over the best prior art available. This case has been pending for an exceeding long duration, and it is time to issue the case. Remember, the Patent Laws, Rules and MPEP not only provide for rejecting claims, but also provide for allowing all claims and issuing patents.

In view of the above remarks and for at least the reasons presented herein, all pending claims are believed to be allowable over the prior art of record, the application is considered in good and proper form for allowance, and the Office is respectfully requested to withdraw all claim objections/rejections, allow all claims, and issue a timely Notice of allowance in this case. If, in the opinion of the Office, a telephone conference would expedite the prosecution of the subject application, the Office is invited to call the undersigned attorney.

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Applicants believes a one-month extension of time is required, and hereby petition for such extension of time required with the requisite fee provided herewith. Additionally, the Commissioner is hereby generally authorized under 37 C.F.R. § 1.136(a)(3) to treat this communication or any future communication in this or any related application filed pursuant to 37 C.F.R. § 1.53 requiring an extension of time as incorporating a request therefore, and the Commissioner is hereby specifically authorized to charge Deposit Account No. 501430 for any fee that may be due in connection with such a request for an extension of time. Moreover, the Commissioner is hereby authorized to charge payment of any fee due any under 37 C.F.R. §§ 1.16 and § 1.17 associated with this communication or any future communication in this or any related application filed pursuant to 37 C.F.R. § 1.53 or credit any overpayment to Deposit Account No. 501430.

Respectfully submitted,
The Law Office of Kirk D. Williams

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By



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